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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/530,147	10/14/2005	Werner Fuchs	P05,0083	1033
26574 7590 03/09/2009 SCHIEF HARDIN, LLP PATENT DEPARTMENT 6600 SEARS TOWER CHICAGO, IL 60606-6473				
EXAMINER PHAM, ANDY L				
ART UNIT 2854		PAPER NUMBER		
MAIL DATE 03/09/2009		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/530,147

Applicant(s)

FUCHS ET AL.

Examiner

ANDY L. PHAM

Art Unit

2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 32, 33, 35-51 and 57-59 is/are pending in the application.
- 4a) Of the above claim(s) 33, 35, 36, 39-51, 58 and 59 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 32, 37, 38 and 57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

1. Claims 32, 37, 38, and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gnuechtel et al. (EP 0 367 368 A1) in view of Keel (US 6,676,066).
2. Regarding claims 32 and 57, Gnuechtel et al. teach a device and method for guiding an endless web, comprising:

a first positionable roll (44) which guides the endless web (40) directly to an additional positionable roll (32) with a predetermined wrap angle on each positionable roll, shafts of said positionable rolls lying parallel to one another in a plane and being held by a frame (**See Figure 3A**);

the web being fed to and led away from the positionable rolls via a respective first stationary roll (42) and a respective additional stationary roll (34); and

the frame being pivotable relative to the stationary rolls about a first axis of rotation which is substantially perpendicular to said plane in order to modify a position of an edge of the web (**See Figures 2 and 3A**).

However, Gnuechtel et al. lack the frame being pivotable relative to the stationary rolls about a second axis of rotation parallel to a movement direction of the web between the first and additional positionable rolls.

Keel teaches a frame being pivotable relative to the stationary rolls about an axis of rotation parallel to a movement direction of the web between the first and additional positionable rolls (**See Figures 2b and 2c**).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have a frame pivotable relative to the stationary rolls about an axis of rotation parallel to a movement direction of the web between the first and additional positionable rolls as taught by Keel for the purpose of maintaining uniform tension on the web as well as to modify a position of the edge of the web.

Gnuechtel et al., as modified by Keel teach in which the frame is displaceable in the second axis of rotation with aid of an adjustment device that is actuated by at least one of the functions selected from the group consisting of manually, electrically, hydraulically, and pneumatically. The adjustment device (steering mechanism) in Gnuechtel et al. uses electrical signals from edge sensors in order to adjust the position of the web (Col 6, lines 38-58).

The functional recitation that the rotation about the first axis combined with the rotation about the second axis prevents sagging of said edge has not been given

patentable weight because it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). Further, it has been held that to be entitled to weight in method claims, the recited structure limitations therein must affect the method in a manipulative sense, and not to amount to the mere claiming of a use of a particular structure. *Ex parte Pfeiffer*, 1962 C.D. 408 (1961).

3. Regarding claim 37, Gnuechtel et al. teach in which along the web there is situated at least one sensor (**82**) whose signal is dependent on a sagging of one side of the web (See Col 6, lines 11-52).

4. Regarding claim 38, Gnuechtel et al. teach in which a sensor is situated in a vicinity of the frame at both sides of the web (**82 and 84**; See Col 6, lines 38-52 and **Figure 4A**).

Response to Arguments

5. Applicant's arguments filed 1/16/2009 have been fully considered but they are not persuasive.

6. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The Keel reference was not relied upon to teach the actuated adjustment

device. The Keel reference is relied upon to show the frame being pivotable relative to the stationary rolls about a second axis of rotation parallel to a movement direction of the web. The Gnuechteal reference was relied upon to show the teaching of using an actuated adjustment device that is actuated by at least one of the functions selected from the group consisting of manually, electrically, hydraulically, and pneumatically (Col 6, lines 38-58).

7. In response to applicant's argument that Keel teaches directly away from the invention of claim 32 which utilizes an actuated adjustment device, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANDY L. PHAM whose telephone number is (571)270-1877. The examiner can normally be reached on Monday-Friday 7:30-5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Nguyen can be reached on (571) 272-2258. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ALP

/Ren L Yan/
Primary Examiner, Art Unit 2854